REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-19, 21-22 are currently pending. Claims 1, 3-5, 10, 13, 16, 21, and 22 are independent. Claims10, 13, 16, 21, and 22 and are hereby amended. No new matter has been introduced. Support for this amendment is provided throughout the Specification as originally filed.

Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. 112

Claims 1-19, 21, and 22 were rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. The Office Action asserted independent claims 1, 3-5, 10, 13, 16, and 21-22 the limitation, ". . . to force the display of first and second advertisement . . . substantially at the same time," ". . . force a viewer to view said first and second ad [sic] . . . before . . ." are not disclosed in the specification.

Applicants respectfully traverse this rejection.

A. As a preliminary matter not all the independent claims recite the elements noted in the Office Action. Therefore, the §112 rejection of each independent claim must be assessed separately.

1. Claims 16, 21, and 22 **do not** recite the limitation, "substantially at the same time" or ". . . force a viewer to view . . . before . . ."

Thus, in claims 16, 21, and 22 the disputed language is only , " . . . "to force display [of] said first and second advertisement-associated data."

The Advisory Action states "In other words, ad windows 271 and 272 displays ad-associated data only when the AV content 151 is being reproduced. Applicant claim limitation reads ". . . first transmitting means for transmitting said first and second advertisement-associated data . . . to said information processing apparatus to force display [of] said first and second advertisement-associated data."

The Office Action seems to imply the claim language does not limit display of the ad-associated information to only when the AV content 151 is being displayed. Applicants respectfully point out the specification does not require the AV content to be displayed at the same time as the ad-associated data, although that possibility is not excluded either. Hence, claims 16, 21, and 22 do not recite this limitation.

The advertisement the viewer "is forced to view" are the first and second advertisement-associated data. This is as clearly shown in FIG. 23, which illustrates first and second advertisements in windows 271 and 272. The areas are described in the Publ. App. pars. [0163]-[0165]. Acquisition of the first and second advertisement-associated data is described throughout the specification, and for this purpose, in Publ. App. pars. [0148]-[0154] and FIGS. 18 and 19.

2. Only claims 5, 10, and 13 recite the limitation, ". . . force a viewer to view said first and second ad . . . before . . ." Claims 5, 10, and 13 have been amended to overcome the rejection cited in the Office Action.

B. The limitation, ". . . to force the display of first and second advertisement . . . substantially at the same time," is disclosed in the specification as follows:

First, claim 1 is representative and recites the "to force the display of said first advertisement-associated data . . . and second advertisement-associated data." Support for forcing display of the first and second advertisement data as recited in claim 1 is found in Publ App. par. [0141]. *See, also,* Publ. App. pars. [0003]-[0004]:

> "Accessing the iEPG site, the user of the personal computer 1 can acquire the preset-recording data free of charge. However, in return for the free preset-recording data, the user is forced to view an advertisement in viewing the television program recorded by use of the preset-recording data.

The advertisement the viewer "is forced to view" are the first and second advertisement-associated data. This is as clearly shown in FIG. 23, which illustrates first and second advertisements in windows 271 and 272. The areas are described in the Publ. App. pars. [0163]-[0165]. Acquisition of the first and second advertisement-associated data is described throughout the specification, and for this purpose, in Publ. App. pars. [0148]-[0154] and FIGS. 18 and 19.

Second, claims 1, and 3-5, recite the additional feature that the first and second advertisement-associated data are displayed, "substantially at the same." Support for this feature is found in Publ. App. pars. [0166]-[0167] and FIG. 23:

"It should be noted that, as long as the image of he AV content 151 being reproduced is displayed in the AV content recording/reproducing window 180, the advertisement windows 271 and 272 cannot be closed. Therefore, when the user of the personal computer 1 views the AV content 151 generated by the preset recording executed in accordance with the settings based on the preset-recording data, he also views the advertisement displayed at the same time.

Also, it should be noted that the advertisement windows 271 and 272 may be opened when the AV content recording/reproducing window 180 is closed to display the image corresponding to the animation GIF file included in the first and second advertisement-associated data."

Thus, the user is forced to view the first and second advertisement-associated data at substantially the same time because when said user views the AV content, the user also views the advertisement displayed in window 271 at the same time. Moreover, the advertisements in windows 271 and 272 are the first and second advertisement associated data.

The Advisory Action refers to claim 1, and 3-5 and states the application only describes forcing the user "to view an advertisement in viewing the television program . . . ([0141]); while viewing the AV content 151, he also views the advertisement (not advertisements) displayed at the same time."

In response Applicants have not limited their claims to only the paragraphs noted in the Advisory Action. Applicants ask reconsideration and point to the as=published application, for example:

". . . Consequently, by use of the preset-recording data, the present invention can display **advertisements** at the same time the preset-recorded television program is displayed." Publ. App. par. [0008]: (emphasis added)

and also,

". . . the displaying of advertisement-associated data supplied from an information providing apparatus is controlled and, if a predetermined condition is satisfied after the displaying of the advertisement-associated data is started, the information thereof is sent to the information providing apparatus. A television program is recorded on an information recording medium on the basis of the preset-recording data supplied from the

information providing apparatus in response to the above-mentioned information. Consequently, **advertisements** can be displayed for those users who use the preset-recording data." Publ. App. par. [0012]: (emphasis added).

and also,

". . . the generated preset-recording data and the obtained advertisement-associated data are sent to an information processing apparatus. Consequently, **advertisements** can be displayed to the user of the information processing apparatus that uses the preset-recording data." Publ. App. par. [0016]: (emphasis added).

Reconsideration of the §112 rejections in view of the above amendments and arguments is earnestly solicited,

III. REJECTIONS UNDER 35 U.S.C. 103

Claims 1-4, 16-19, 21 and 22 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2002/0046407 to Franco (hereinafter, merely "Franco") in view of U.S. Patent No. 6,536,041 to Knudsen (hereinafter, merely "Knudsen") and further in view of U.S. Patent No. 6,588,015 to Eyer et al. (hereinafter, merely "Eyer") and Official Notice;

Claims 5-15 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Franco, Knudsen and Eyer and further in view of U.S. Patent No. 6,704,929 to Ozer et al. (hereinafter, merely "Ozer") and also under Official Notice.

Applicants respectfully traverse these rejections.

As stated in the present Office Action at page 2, par. 3, the amended claim limitations made in Applicants February 8, 2008 have not been considered. Applicants have overcome the §112 rejections without amendment and request consideration of the amendments on the merits.

Claim 1 is representative and recites, *inter alia:*

". . . receiving means for receiving said preset-recording data, keyword data, and first advertisement-associated data from said information providing apparatus in response to said television program identifying information and second advertisement-associated data from said information providing apparatus in response to said keyword data;
. . .
. . . force the display of said first and second advertisement-associated data substantially at the same time to force a viewer to playback said first and second advertisement-associated data while simultaneously playing back said television program." (Emphases added)

Applicants respectfully submit the combination of Franco, Knudsen, Eyer and Ozer does not teach the above-recited feature of claim 1. In particular, in an aspect of the present invention, two advertisements are received in response to transmitting a request for the preset-recording data. A first advertisement is responsive to program identifying information. A second advertisement is responsive to the keyword data. Moreover, both the first a second advertisements are displayed at the same time while the television program is also being played back.

In an example from the specification, a program to be recorded is identified by the recording date and channel data received. The advertisement site sends the first advertisement-associated data supplied by a sponsor who purchased the corresponding advertisement frame on the television program based on the recording date/time and channel data. Publ. App. pars. [0150]-[0152] and FIG. 19.

Also, the advertisement site matches the program keyword to a second advertisement based upon a relationship managed by the advertisement site. Publ. App. par. [0156] and FIG. 22.

By executing the above-mentioned advertisement-associated data acquisition processing, the first advertisement is related to the program date/time/channel purchased by the sponsor of the program. The second advertisement is related to the keyword associated with the program.

Both the first and second advertisements are displayed at the same time on the screen along with the television program. Publ. App. par. [0163] and FIG. 23.

The above-described feature is not described in the combination of Franco, Knudsen, Eyer and Ozer.

For reasons similar, or somewhat similar, to those described above with regard to independent claim 1, independent claims 3-5, 10, 13, 16, and 21-22 are also patentable.

IV. DEPENDENT CLAIMS

The other claims are each dependent from one of the independent claims discussed above, and are therefore patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

All claims are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference(s), it is respectfully requested that the Examiner specifically indicate those portion(s) of the reference(s), providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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